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| APPLICATION NO.     | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------|-------------|----------------------|---------------------|------------------|
| 10/622,299          | 07/18/2003  | Arvind N. Shah       | CR44U-US            | 7273             |
| 60723               | 7590        | 12/27/2007           | EXAMINER            |                  |
| AVON PRODUCTS, INC. |             |                      | KANTAMNENI, SHOBHA  |                  |
| AVON PLACE          |             |                      | ART UNIT            | PAPER NUMBER     |
| SUFFERN, NY 10901   |             |                      | 1617                |                  |
|                     |             |                      | MAIL DATE           | DELIVERY MODE    |
|                     |             |                      | 12/27/2007          | PAPER            |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/622,299

**Applicant(s)**

SHAH ET AL.

**Examiner**

Shobha Kantamneni

**Art Unit**

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,5-14 and 21-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) NONE is/are allowed.
- 6) ☒ Claim(s) 1,5-14,21-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/02/2007 has been entered.

Applicant's amendment filed on 10/02/2007, wherein claims 1, and 14 have been amended.

Claims 1, 5-14, 21-29 are pending, and examined herein.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 5-14, and 21-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation "bismuth oxychloride-containing pearlescent ingredient bonded to a colorant" is ambiguous, and the specification fails to define this recitation. It is not clear as to the term bonded. Is bismuth oxychloride chemically bonded to a colorant? If

it is a chemical bond, it is further not clear if bismuth oxychloride is bonded to the colorant by a covalent bond, or non-covalent bond (ionic, van der Waals bonding etc).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5-10, 13, 14, 21-26, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tan et al. (US 6,511,672, PTO-892 of record).

Tan et al. disclose cosmetic composition for topical application to skin comprising a first platelet of alumina treated with metal oxide such as iron-oxide, a second platelet for example mica, bismuth oxychloride, alumina, copper, bronze, silver or silica treated with a spherical scattering component. It is also taught that iron oxides as pigments match the color of the skin i.e the first platelet alumina is matched in shade with a natural skin tone. See abstract; column 1, lines 19-21; col. 3, line 30-col. 4, line 22. It is disclosed that the two platelets together which include first platelet and second platelet form the mosaic which gently reflects light and matches the natural color of the skin. See column 3, lines 31-36. It is further taught that the composition comprising first platelet, and second platelet, which together match the natural color of the skin further comprises non-interference pigment. See column 9, claims 8-9. It is taught that the non-

interference pigments provide color to match the color of the skin tone i.e the non-interference pigment component also matches the natural skin tone. See column 6, lines 22-26. The method of preparing the cosmetic composition by blending the platelets and pigments is also disclosed. See col. 8, claims 1-3. It is further disclosed that the combination of platelets and pigments creates a mosaic of color and optically manipulates light such that the lines, wrinkles, disfigurations and discolorations on the skin appear to substantially vanish and the net effect is the skin appears natural, luminous and flawless. See abstract; column 4, lines 20-21; column 6, lines 15-49; column 8, claims 1,3. Inorganic pigments, and organic pigments are used in the composition. The second platelet comprising bismuth oxychloride is present in an amount of 0.1 to 10.0 %, and the pigments are present in an amount of 0.05 to 50 % by weight. See column 4, lines 33-35; column 5, lines 12-15. The makeup products include foundations, blushes, pressed or loose powders, concealers, bronzers, lipsticks, lipglosses. Also the products can be in the form of gels, sticks, water-in oil emulsions, sprays, pressed or loose powders. See column 6, lines 59-66. For liquid foundation a water-in-oil emulsion is preferred, and the oil component comprises a silicone oil. See column 7, lines 4-9; column 8, EXAMPLE 1.

Tan et al. do not explicitly teach the particular platelet, bismuth oxychloride as the second platelet in the composition therein.

It would have been obvious to a person of ordinary skill in the art at the time of invention to employ bismuth oxychloride as the second platelet because Tan teaches that the second platelet can be mica, bismuth oxychloride, alumina, copper or bronze

etc. One of ordinary skill in the art would have been motivated to employ bismuth oxychloride as second platelet with reasonable expectation of success of obtaining a composition that matches the natural color of the skin on blending with the first platelet because Tan teaches that the two platelets together which include first platelet and second platelet form the mosaic which gently reflects light and matches the natural color of the skin.

Regarding, the recitation "a pearlescent component comprising a bismuth oxychloride-containing pearlescent ingredient bonded to a colorant" in claims 1, and 14, the composition disclosed by Tan et al comprises a colored pigment i.e alumina platelet treated with iron-oxide and bismuth oxychloride, and thus will contain a colored pigment bonded to bismuth oxychloride.

Furthermore, as the teachings of Tan et al. renders the claimed composition obvious, the property of such a claimed composition will also be rendered obvious by the prior art teachings, since the properties, namely the pearlescent component matches in shade a natural skin tone, are inseparable from its composition. Therefore, if the prior art teaches the composition or renders the composition obvious, then the properties are also taught or rendered obvious by the prior art. In re Spada, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990.) See MPEP 2112.01. Further, note that Tan teaches that the two platelets together which include first platelet and second platelet form the mosaic which gently reflects light and matches the natural color of the skin.

***Response to Arguments:***

Applicant's arguments have been considered but are not persuasive in view of the new ground(s) of rejections presented in this office action, and as discussed below.

Applicant argues that "Tan's blends clearly do not have a "bond" between the first and second platelets under the plain meaning of the term, as evidenced by these dictionary definitions, because there is nothing to bind the platelets to one another." These arguments have been considered, but not found persuasive. It is pointed out that the recitation "a bismuth oxychloride-containing pearlescent ingredient bonded to a colorant" in instant claim 1, is a product-by-process limitation. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 21 13.

Applicant argues that "the application discloses that the "pearlescent ingredient preferably is a combination of colored pigment bonded to bismuth oxychloride and mica using calcium stearate" (page 8, lines 8-10). Thus, one skilled in the art would understand from reading Applicant's disclosure that the pearlescent ingredient is not a blend of a colored pigment and bismuth oxychloride containing ingredient". These arguments have been considered, but not found persuasive because the instant claims broadly comprise "a bismuth oxychloride-containing pearlescent ingredient bonded to a colorant", and do not recite calcium stearate as an ingredient. Thus, given the broadest

reasonable interpretation the term "bonded" in the instant claim can mean covalent or non-covalent bond which can occur by simple mixing of ingredients. It is pointed out that claims are given their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023,1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim should not be read into the claim. E-Pass Techs., Inc. v. 3Com Corp., 343 F.3d1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-12, and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tan et al. as applied to claims 1, 5-10, 13-14, 21-26, and 29 above in view of Breiva et al. (US 5,800,816, PTO-892 of record).

Tan et al. is as discussed above.

Tan et al. does not teach that the silicone emulsion composition therein comprises isodecane, and the amount of isodecane.

Breiva et al. discloses a method of making water in silicone emulsion make up composition comprising silicone polymer, cyclomethiocone/dimethicone copolyol;



pearlescent ingredient, mica; pigments such as red iron oxide, yellow iron oxide, and water is also disclosed. The composition can comprise from about 0.1-60 % of volatile components which include straight or branched chain hydrocarbons such as isododecane. See column 2, lines 44-46; EXAMPLE 2.

It would have been obvious to a person of ordinary skill in the art at the time of invention to employ isododecane in the compositions of Tan et al. because Breiva teaches analogous silicone emulsion compositions, useful as make up products containing additives such as isododecane.

It would have been obvious to one of ordinary skill in the art to employ the specific weight percentages of the isododecane as claimed in the instant invention because it is taught by Breiva that water in silicone emulsion make up composition comprising silicone polymer, cyclomethiocone/dimethicone copolyol; pearlescent ingredient, mica; pigments such as red iron oxide, yellow iron oxide, and water comprise from about 0.1-60 % of volatile components which include straight or branched chain hydrocarbons such as isododecane. Accordingly, Breiva teaches an analogous art comprising the instant isododecane within the amount ranges as claimed in the instant application. One would have been motivated to add isododecane in the weight percentage of the instant application to the composition of Tan et al. because as taught by Breiva, such preparations are useful as make up products.

It has been held that it is within the skill in the art to select optimal parameters, such as amounts of ingredients, in a composition in order to achieve a beneficial effect. See *In re Boesch*, 205 USPQ 215 (CCPA 1980).

**Conclusion**

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shobha Kantamneni whose telephone number is 571-272-2930. The examiner can normally be reached on Tuesday-Thursday, 8.00am-4.00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, Ph.D can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shobha Kantamneni, Ph.D  
Patent Examiner  
Art Unit : 1617

  
